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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,811	12/29/2000	Robert E. Gleichauf	062891.0462	8466
7590	05/17/2005			EXAMINER
Barton E. Showalter Baker Botts L.L.P. 2001 Ross Avenue Dallas, TX 75201-2980			MOORTHY, ARAVIND K	
			ART UNIT	PAPER NUMBER
			2131	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/751,811	GLEICHAUF, ROBERT E.
	<b>Examiner</b>	<b>Art Unit</b>
	Aravind K. Moorthy	2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 04 April 2005.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-39 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 December 2000 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

1. This is in response to the amendment filed on 4 January 2005.
2. Claims 1-39 are pending in the application.
3. Claims 1-39 have been rejected.

### ***Continued Examination Under 37 CFR 1.114***

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 April 2005 has been entered.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1-39 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an

international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**6. Claims 1-6, 12, 14, 16-20, 22, 27, 29-31, 36 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Sawa U.S. Patent No. 6,477,708 B1.**

As to claims 1, 29 and 36, Sawa discloses a method for real-time insertion of services during a telephony call session over a communication network, comprising:

- initiating a service request message by a first client to a first server, the service request message initiated after a telephony call session has been established between the first client and a communication network the service request message including the first client identity and a requested service available from a second server comprising a plurality of services [column 6 line 20 to column 8 line 7];
- determining that the first client is authorized to use the requested service at the first server [column 6 line 20 to column 8 line 7];
- and delivering the requested service to the first client during the established call session by the second server in response to determining that the first client is authorized to use the requested service [column 6 line 20 to column 8 line 7].

As to claims 2 and 17, Sawa discloses that at least one of the services comprises an application operable to provide text viewing and modification capabilities [column 6 line 20 to column 8 line 7].

As to claims 3 and 18, Sawa discloses that at least one of the services comprises an application operable to provide graphic viewing and modification capabilities [column 6 line 20 to column 8 line 7].

As to claims 4 and 19, Sawa discloses that the requested service is only available during the telephony call session [column 6 line 20 to column 8 line 7].

As to claims 5, 20 and 30, Sawa discloses the method further comprising:

- comparing the first client identity and the requested service with a list stored in the first server, the list comprising a plurality of clients authorized to use at least one of the services available from the second server [column 6 line 20 to column 8 line 7];
- and issuing a ticket to the first client if the list includes authorization for the first client to use the requested service [column 3 line 59 to column 4 line 14].

As to claims 6, 31 and 37, Sawa discloses the method further comprising:

- comparing the first client identity and the requested service with a list stored in the first server, the list comprising a plurality of clients authorized to use at least one of the services available from the second server [column 6 line 20 to column 8 line 7];
- issuing a ticket to the first client in response to determining that the list includes authorization for the first client to use the requested service, the ticket including the first client identity and the requested service; sending the ticket to the second server by the first client [column 3 line 59 to column 4 line 14];
- and reading the ticket at the second server to retrieve the requested service [column 3 line 59 to column 4 line 14].

As to claims 12 and 27, Sawa suggests pressing a button associated with the requested service at the first client during a telephony call session to initiate the service request message [column 8 line 55 to column 9 line 7].

As to claim 14, Sawa discloses a communication system, comprising:

- establish a telephony call session between the client and a communication network [column 6 line 20 to column 8 line 7]; and
- initiate a service request message after the call session has been established, the service request message including a client identifier and a requested service to be inserted into the telephony call session [column 6 line 20 to column 8 line 7];
- a first device operable to couple to the communication network, the first device comprising a list of clients authorized to use at least one of a plurality of services [column 6 line 20 to column 8 line 7];
- and a second device operable to couple to the communication network, the second device further operable to insert the requested service into the established call session in response to determining that the list includes the client identifier and the requested service [column 6 line 20 to column 8 line 7].

As to claim 16, Sawa discloses that the first device is operable to determine that the client is authorized to use the requested service [column 6 line 20 to column 8 line 7].

As to claim 22, Sawa suggest that the communication system further comprises:

- a plurality of remote clients coupled to the communication network [column 3 line 59 to column 4 line 14];

- and a plurality of remote second devices coupled to the communication network, each remote second device associated with at least one of the remote clients [column 3 line 59 to column 4 line 14].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claims 7-11, 21, 23-26, 32-35, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawa U.S. Patent No. 6,477,708 B1 as applied to claims 1, 14, 29 and 36 above, and further in view of Bittinger et al U.S. Patent No. 6,477,708 B1.**

As to claims 7, 8, 10, 11, 21, 23-26, 32, 33, 35, 38 and 39, Sawa teaches comparing the first client identity and the requested service with a list stored in the first server [column 6 line 20 to column 8 line 7]. Sawa teaches that the list comprises a plurality of clients authorized to use at least one of the services available from the second server [column 6 line 20 to column 8 line 7]. Sawa teaches issuing a ticket to the first client in response to determining that the list includes authorization for the first client to use the requested service [column 3 line 59 to column 4 line 14]. Sawa teaches that the ticket includes the first client identity and the requested service [column 3 line 59 to column 4 line 14].

Sawa does not teach sending the ticket and an address associated with a second client to the second server by the first client. Sawa does not teach reading the ticket at the second server

to retrieve the requested service for a second client. Sawa does not teach delivering the requested service to the second client based on the address received from the first client.

Bittinger et al teaches sending the ticket and an address associated with a second client to the second server by the first client. Bittinger et al teaches reading the ticket at the second server to retrieve the requested service for a second client. Bittinger et al teaches delivering the requested service to the second client based on the address received from the first client [column 7, lines 1-49].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sawa so that the ticket sent from the first client to the second server included the address associated with a second client. The second server would have read the ticket and retrieved the requested service. The service would have been delivered to the second client based on address received from the first client.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sawa by the teaching of Bittinger et al because by moving a server-side registry to a computer hosting a client application (i.e., a "client-side" registry), a server application can notify a client application when server application startup processing is complete and can provide a server stub associated with the server application to the client application. As a result, a client application can be automatically notified that a server application is ready to receive client application requests. Consequently, the need for server polling may be eliminated [column 3 line 65 to column 4 line 7].

As to claims 9 and 34, Sawa teaches comparing the first client identity and the requested service with a list stored in the first server. Sawa teaches that the list comprises a plurality of

clients authorized to use at least one of the services available from the second server [column 6 line 20 to column 8 line 7]. Sawa teaches issuing a ticket to the second server in response to determining that the list includes authorization for the first client to use the requested service [column 3 line 59 to column 4 line 14].

**8. Claims 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sawa U.S. Patent No. 6,477,708 B1 as applied to claims 1 and 14 above, and further in view of Lancaster et al U.S. Patent No. 5,854,894.**

As to claims 13 and 28, Sawa does not teach selecting the requested service from a menu displayed on the first client during a telephony call session to initiate the service request message.

Lancaster et al teaches selecting a requested service from a menu displayed on the first client during a telephony call session to initiate the service request message [column 2, lines 12-18].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sawa so that client selected the desired service from a service menu display to initiate the service request message.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sawa by the teaching of Lancaster et al because a menu provides a means for a client to know what services are available by a second server.

**9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sawa U.S. Patent No. 6,477,708 B1 as applied to claim 14 above, and further in view of Berbec et al U.S. Patent No. 6,122,631.**

As to claim 15, Sawa does not teach that the client further comprises a cache operable to store a requested service and the requested service removable from the cache when the telephony call session terminates.

Berbek et al teaches a client that comprises a cache operable to store a requested service and the requested service removable from the cache when the telephony call session terminates [column 5, lines 19-27].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sawa so that client would have stored the requested service in cache and would have removed the requested service from cache when the call session terminated.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Sawa by the teaching of Berbec et al because this allows the client to access files dynamically and allow the server to distribute files in a secure manner [column 1, lines 47-61]

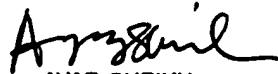
***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K. Moorthy whose telephone number is 571-272-3793. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy  
May 6, 2005

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100